REMARKS

1. In response to the first Office Action mailed September 11, 2006, Applicants respectfully request reconsideration. Claims 1-20 were originally presented for examination. Claims 1-20 were rejected in the outstanding Office Action. No Claims have been canceled or added. Claims 1, 15, and 20 have been amended. Thus, upon entry of this paper, claims 1-26 will remain pending in this application. Of these twenty (20) claims, three (3) claims (claims 1, 15 and 20) are independent. Based on the above Amendments and following Remarks, Applicant respectfully requests that the outstanding objections and rejections be reconsidered, and that they be withdrawn.

Art of Record

2. Applicants acknowledge receipt of form PTO-892 identifying additional references made of record by the Examiner.

3. Applicants thank the Examiner for returning form PTO-1449 filed by Applicant on August 12, 2003 which have been initialed by the Examiner indicating consideration of the references cited therein.

Drawings

4. Applicant notes with appreciation the Examiner's indication that the drawings filed on August 12, 2003 have been accepted as formal drawings.

Specification Objections

5. The Examiner objected to the specification because the disclosure contains some information that requires updating. Applicants have amended the specification and accordingly respectfully request that the Examiner reconsider and withdraw the objections to the specification.

Claim Objections

6. The Examiner objected to claims 1 and 20 for informalities. Applicants have amended claims 1 and 20 and accordingly respectfully request that the Examiner reconsider and withdraw the objection to the claims.

Double Patenting Rejections

7. The Examiner has provisionally rejected claims 6 and 20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of copending Application No. 10/640,623.

8. Applicants have filed concurrently with this paper a terminal disclaimer disclaiming the terminal part of the statutory term of any patent granted on the captioned application, which would extend beyond the expiration date of the full statutory term of United States Application No. 10/640,623. Applicants respectfully assert that these rejections have been obviated by the filing of the terminal disclaimers.

9. Applicants have submitted the terminal disclaimers solely to advance the prosecution of the application, without conceding that the double patenting rejection is properly based. In filing the terminal disclaimers, Applicants rely upon the rulings of the Federal Circuit that the filing of such a terminal disclaimer does not act as an admission, acquiescence or estoppel on the merits of the obviousness issue. See, e.g., Quad Environmental Tech v. Union Sanitary Dist., 946 F.2d 870, 874-875 (Fed. Cir. 1991); Ortho Pharmaceutical Corp. v. Smith, 959 F.2d 936, 941-942 (Fed. Cir. 1992).

Claim Rejections under 35 U.S.C. §101

10. Independent claim 20 has been rejected under 35 U.S.C §101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants have amended claim 20 so that it recites that the instructions are operable by a computer. As such, Applicants respectfully request that the Examiner reconsider and withdraw the rejection to claim 20.

Claim Rejections under 35 U.S.C. §102 and §103

11. Independent claim 1 and dependent claims 2-12 have been rejected under 35 U.S.C §102(e) as being anticipated by U.S. Publication No. 2003/0195959 to Labadie, *et al.* (hereinafter, "Labadie"). Dependent claims 13 and 14 have been rejected under 35 U.S.C §103(a) as being unpatentable over Labadie and further in view of U.S. Patent No. 7,003,565 to Hind, *et al.* (hereinafter, "Hind"). Independent claim 15 and dependent claims 16-19 have been rejected under U.S.C §103(a) as being unpatentable over Labadie and further in view of U.S. Publication No. 2003/0120593 to Bansal, *et al.* (hereinafter,

"Bansal"). Independent claim 20 has been rejected under 35 U.S.C §102(e) as being anticipated by U.S. Publication No. 2004/0220947 to Aman, *et al.* (hereinafter, "Aman"). Also, Based on the above Amendments and following Remarks, Applicants respectfully request that these rejections be reconsidered, and that they be withdrawn.

12. Independent claim 1, recites, in part, "for each of selected ones of said transactions, instrumenting said transaction at run-time without modifying its source code to obtain a performance metric corresponding thereto...." In rejecting claim 1, the Examiner asserted that Labadie discloses this limitation. In support, the Examiner relied on FIGs. 4A-4C of Labadie. (*See*, Office Action at 7.) Applicants respectfully disagree.

13. Labadie is directed to a framework for managing data that provides correlation information in a distributed computing system. (*See*, Labadie at Abstract.) FIGs. 4A-4C of Labadie illustrate event occurrence time lines and counter assignments to the events of various process/thread/provider scenarios. (*See*, Labadie at para 23.) More particularly, FIG. 4A of Labadie illustrates an event line for each of two threads of a process instrumented by a single provider. (*See*, Labadie at para 55.) As such, contrary to the Examiner's assertion, these Figures do not disclose instrumenting a transaction at run-time without modifying its source code. Rather, Labadie discloses that these threads are already instrumented prior to the events illustrated by FIG. 4A. Moreover, Labadie discloses in a separate section of Labadie that incorporating a logging provider into an application is accomplished by including invocations of the provider service at selected points in the application code that defines an event of interest to be logged by the logging provider. (*See*, Labadie at para. 60). As such, contrary to the Examiner's assertions Labadie does not teach or suggest instrumenting a transaction at run-time without modifying its source code.

14. The Examiner further appeared to rely on an alleged teaching in Labadie of "[m]iddleware instrumenting of live events and transaction threads..." (*See*, Office Action at 7.) The Examiner, however, identified no citation in Labadie supporting this alleged teaching and a simple search of the Labadie application for the above phrase found that Labadie includes no such phrase.

15. As such, Applicants respectfully request that the Examiner reconsider and withdraw the rejection to claim 1 for at least the reason that Labadie fails to teach or suggest "for each of selected ones of said transactions, instrumenting said transaction at run-time

without modifying its source code to obtain a performance metric corresponding thereto..." as recited by claim 1. Applicants therefore respectfully request that the rejection to claim 1 be withdrawn.

16. Independent claim 15 recites, in part, "instrumenting each of said transactions at run-time by modifying its respective bytecode representation to obtain a selected performance metric corresponding thereto." In rejecting claim 1, the Examiner did not identify any particular disclosure of Labadie or Bansal for allegedly disclosing this limitation. Instead, the only specific citations provided by the Examiner in the Office Action for rejecting independent claim 15 appear to be related to utilizing RIOP over IOP. Thus, it appears that the Examiner is relying on the identical bases for rejecting this limitation of claim 15 as the Examiner relied on in rejecting the above-discussed limitation of claim 1. As such, Applicants respectfully submit that for at least similar reasons to those discussed above Labadie fails to teach or suggest "instrumenting each of said transactions at run-time by modifying its respective bytecode representation to obtain a selected performance metric corresponding thereto," as recited by claim 15. Bansal does not cure, nor has the Examiner alleged that it cures, the above-noted defect of Labadie. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claim 15 for at least these reasons.

17. Independent claim 20 recites, in part, "instrumenting at run-time a hierarchical chain of parent-child transactions ... without modifying source codes associated with these transactions...." In rejecting claim 20, the Examiner alleged that Aman discloses this limitation. In support, the Examiner relied on paragraphs 126-128 and FIGs. 4 and 12 of Aman. (*See*, Office Action at 6.) Applicants respectfully disagree.

18. Aman is directed to workload reporting in a distributed transaction processing environment having call trees in which a child application performs a child transaction on behalf of a parent application performing a parent transaction. (*See*, Aman at Abstract.) Paragraphs 126-128 of Aman disclose dynamically linking shared libraries that export ARM API function calls. (*See*, Office Action at para 126.) This section further discloses that a workload reporter may gain an understanding of the flow of work across multiple operating platforms throught the interaction between "instrumented applications" and the workload reporter via "the instrumentation interfaces." (*See*, Office Action at 128.) As such, this portion (i.e., paras. 126-128.) already assumes that the instrumentation has

occurred. Thus, this portion of Aman accordingly fails to teach or suggest instrumenting at run-time a hierarchical chain of transactions without modifying the source codes.

19. FIGs. 4 and 12 of Aman likewise do not cure this defect. FIG. 4 illustrates a system 304 that contains a local agent 402 and one or more instrumented applications. (*See*, Aman at para 67.) As such, like paragraphs 126-128 of Aman, FIG. 4 deals with applications that are already instrumented. Accordingly, FIG. 4 of Aman fails to teach or suggest instrumenting at run-time a hierarchical chain of transactions without modifying the source codes.

20. FIG. 12 of Aman is likewise deficient. FIG. 12 illustrates how applications call an ARM API when a transaction starts and ends in the system of Aman. (*See*, Aman at para. 51 and 191.) This figure and its corresponding description, however, do not disclose instrumenting these applications, but instead they merely disclose that an application calls an ARM API when a transaction starts and ends. Accordingly, FIG. 12 of Aman fails to teach or suggest instrumenting at run-time a hierarchical chain of transactions without modifying the source codes.

21. It should be noted that the in the Office Action, the Examiner appears to allege that FIG. 12 discloses the dynamic insertion of an API call via ARM services and that this allegedly discloses instrumenting a transaction without modifying the transaction's source code. (*See*, Office Action at 6.) FIG. 12, however, does not illustrate the dynamic insertion of an API call via ARM services into an application. Rather, FIG. 12 illustrates that an application calls an ARM API. (*See,* Aman at para. 191.)

22. As such, Applicants respectfully submit that Aman fails to teach or suggest "instrumenting at run-time a hierarchical chain of parent-child transactions ... without modifying source codes associated with these transactions...," as recited by independent claim 20. Applicants accordingly respectfully request that the Examiner reconsider and withdraw the rejection to claim 20 for at least this reason.

Dependent Claims

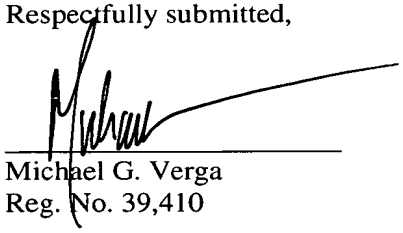
23. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them *a fortiori* independently patentable over the art of record. Accordingly, Applicants respectfully

request that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

Conclusion

24. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,



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November 27, 2006